

## **REMARKS**

Claims 1-19 and 21-30 are currently pending in the application. Only claims 1 and 21 are in independent form.

Claims 1-7 stand rejected under 35 U.S.C. § 102(b) as being anticipated by the Dean patent. Reconsideration of the rejection under 35 U.S.C. § 102(b), as anticipated by the Dean patent, as applied to the claims is respectfully requested. Anticipation has always been held to require absolute identity in structure between the claimed structure and a structure disclosed in a single reference.

In Hybritech Inc. v. Monoclonal Antibodies, Inc., 802 F.2d 1367, 231 U.S.P.Q. 81 (Fed. Cir. 1986) it was stated: "For prior art to anticipate under §102 it has to meet every element of the claimed invention."

In Richardson v. Suzuki Motor Co., Ltd., 868 F.2d 1226, 9 U.S.P.Q.2d 1913 (Fed. Cir. 1989) it was stated: "Every element of the claimed invention must be literally present, arranged as in the claim."

The Office Action states that the Dean patent discloses an apparatus for moving a container such that the container is rotated relative to the frame and rolled along a surface. However, when read more specifically, the Dean patent discloses a garden roller that utilizes sockets to enable a roller to be attached to stems. There is no disclosure of clamping the roller between the stems.

The system of the Dean patent could not function properly if merely clamped into place because a water supply is connected to the interior of the drum. Water is then added to the drum and subsequently dispersed from the drum onto the desired location. Therefore, if the device of the Dean patent were merely clamped into place, water would leak out of the container and render the device useless.

The Dean patent does not disclose or suggest an apparatus having a mechanism for clamping a container such that the container can be then rolled along a surface. Instead, the Dean patent discloses a device for connecting a drum to stems. Further, the container disclosed in the Dean patent is not held in clamping engagement with the stems, but instead is directly connected to the stems.

The Office Action states that the Dean patent discloses clamping members such that the container is clamped between the first and second clamping members as broadly recited. However, as shown in Figure 2 of the Dean patent, the container instead requires that there be a direct connection between the frame and the container so that there can be a water conduit connection between the container and the frame. In other words, there is no clamping that is shown in Figure 2. Instead, Figure 2 shows that the frame is pivotally connected to the drum and that the drum is shaped such that it is specifically designed to have place within its exterior surface parts of the frame. There is no clamping that occurs. Instead the drum is merely placed between the arms of the frame and the water/water connection is made therebetween. (See specifically Part 9 in Figure 2). There is therefore no disclosure of the clamping relationship in the Dean patent. In contradistinction, the presently pending independent claims claim a device for clamping a container while enabling the container to be rolled. The Dean patent neither suggests nor teaches the apparatus of the presently pending independent claims. The claims are therefore patentable over the Dean patent and reconsideration of the rejection is respectfully requested.

Claims 21-28 stand rejected under 35 U.S.C. § 102(b) as being anticipated by the Dean patent. Reconsideration of the rejection under 35 U.S.C. § 102(b), as anticipated by the Dean patent, as applied to the claims is respectfully requested. Anticipation has always been held to require absolute identity in structure between

the claimed structure and a structure disclosed in a single reference.

The Office Action states that the method of the Dean patent includes steps of fixing a frame to a roller or a container and rotating the container relative to the frame. However, when read more specifically, the Dean patent discloses a garden roller that utilizes sockets to enable a roller to be attached to stems. There is no disclosure for clamping the roller drum between the stems. Further, the system of the Dean patent would not function properly if a clamping engagement was used because a water supply is connected to the interior of the drum and therefore the connection cannot merely be made via a clamp, but instead, must involve a fluid connection. The apparatus of the Dean patent thus does not disclose or suggest a container that can then be rolled along a surface. Instead, the Dean patent discloses a device for connecting a container to a stem thereby forming a single unit. Further, the container is not held in a clamping engagement with the stems, but is instead directly connected to the stems.

The Office Action states that the Dean patent discloses that the container is clamped between the first and second clamping members, as broadly recited. However, the container of the Dean patent instead requires that there be a direct connection between the frame and the container as there is a water connection between the container and the frame. In other words, there is no clamping that is shown in Figure 2. Instead, Figure 2 shows that the frame is pivotally connected to the container and that the container is specifically shaped to engage the frame. There is no clamping that occurs. Instead, the container merely engages the arms of the frame and a water/water connection is made therebetween. (See specifically Part 9 in Figure 2). There is therefore no disclosure of the clamping relationship in the Dean patent. In contradistinction, the presently pending independent claims claim a device for clamping a container while enabling the container to be rolled. Therefore, the Dean patent neither suggests nor teaches the apparatus of the presently pending

independent claims, the claims are patentable over the Dean patent, and reconsideration of the rejection is respectfully requested.

Claims 8-11 and 30 stand rejected under 35 U.S.C. §103(a) as being obvious over the Dean patent in view of the Henderson et al. patent. Reconsideration of the rejection under 35 U.S.C. §103(a) over the Dean patent in view of the Henderson et al. patent, as applied to the claims is also respectfully requested.

It is Hornbook Law that before two or more references may be combined to negative patentability of a claimed invention, at least one of the references must teach or suggest the benefits to be obtained by the combination. This statement of law was first set forth in the landmark case of Ex parte McCullom, 204 O.G. 1346; 1914 C.D. 70. This decision was rendered by Assistant Commissioner Newton upon appeal from the Examiner-in-Chief and dealt with the matter of combination of references. Since then many courts have, over the years, affirmed this doctrine.

The applicable law was more recently restated by the Court of Appeals for the Federal Circuit in the case of ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929 (Fed. Cir. 1984). In this case the Court stated, on page 933, as follows:

Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under Section 103 teachings of references can be combined only if there is some suggestion or incentive to do so. The prior art of record fails to provide any such suggestion or incentive. Accordingly we hold that the court below erred as a matter of law in concluding that the claimed invention would have been obvious to one of ordinary skill in the art under section 103.

This Doctrine was even more recently reaffirmed by the CAFC in Ashland Oil, Inc. v. Delta Resins and Refractories, Inc., et al., 776 F.2d 281,297, 227 U.S.P.Q. 657,667. As stated, the District Court concluded:

Obviousness, however, cannot be established by combining the teachings of the prior art to produce the claimed invention unless there was some teaching, suggestion, or incentive in this prior art, which would have made such a combination appropriate.

The Court cited ACS Hospital Systems, Inc. in support of its ruling. This Doctrine was reaffirmed in In re Deuel, 34 USPQ2d 1210 (Fed. Cir. 1995).

The Office Action states that the method of the Dean patent includes steps of fixing a frame to a roller or a container and rotating the container relative to the frame. However, when read more specifically, the Dean patent discloses a garden roller that utilizes sockets to enable a roller to be attached to stems. There is no disclosure for clamping the roller drum between the stems. Further, the system of the Dean patent would not function properly if a clamping engagement was used because a water supply is connected to the interior of the drum and therefore the connection cannot merely be made via a clamp, but instead, must involve a fluid connection. The apparatus of the Dean patent thus does not disclose or suggest a container that can then be rolled along a surface. Instead, the Dean patent discloses a device for connecting a container to a stem thereby forming a single unit. Further, the container is not held in a clamping engagement with the stems, but is instead directly connected to the stems.

The Office Action states that the Dean patent discloses clamping members such that the container is clamped between the first and second clamping members as broadly recited. However, the container of the Dean patent instead requires that there be a direct connection between the frame and the container as there is a water connection between the container and the

frame. In other words, there is no clamping that is shown in Figure 2. Instead, Figure 2 shows that the frame is pivotally connected to the container and that the container is specifically shaped to engage the frame. There is no clamping that occurs. Instead the container merely engages the arms of the frame and a water/water connection is made therebetween. (See specifically Part 9 in Figure 2). There is therefore no disclosure of the clamping relationship in the Dean patent. In contradistinction, the presently pending independent claims claim a device for clamping a container while enabling the container to be rolled. Therefore, the Dean patent neither suggests nor teaches the apparatus of the presently pending independent claims, the claims are patentable over the Dean patent, and reconsideration of the rejection is respectfully requested.

The Office Action states that the Henderson et al. patent discloses an apparatus for transporting a tank and other diving gear. The apparatus includes a frame that has a handle section and a roller. The roller includes a metal rod about which a plastic tube and roller rotate. Thus, the roller functions as a wheel, and later as a buoyant device, but does not enable the roller to be removed and added or to be exchanged for a different piece of material. There is no disclosure for an apparatus that clamps a device within the arms of the clamping device while permitting the device to be rolled. This is distinctly different than the device of the presently pending independent claims, which instead claim a device for clamping a container therebetween without requiring an axle. Since neither the Dean nor the Henderson et al. patents, either alone or in combination, disclose or suggest the method and device of the presently pending independent claims, the claims are patentable over the Dean and Henderson et al. patents. Reconsideration of the rejection is respectfully requested.

The remaining dependent claims not specifically discussed herein are ultimately dependent upon the independent claims. References as applied against these dependent claims do not make up for the deficiencies of those references as discussed above. The prior art references do not disclose the characterizing features of the independent claims discussed above. Hence, it is respectfully submitted that all of the pending claims are patentable over the prior art.

It is respectfully requested that the present amendment be entered in order to place the application in condition for allowance or at least in better condition for appeal. The application is placed in condition for allowance as it addresses and resolves each and every issue that remains pending. Claims have also been amended to clearly distinguish over the prior art. The application is made at least in better condition for appeal as the amendment removes many issues, thereby simplifying the issues on appeal. Further, the claims have been amended to more specifically define the invention while raising no new issues that would require any further searching. Rather, the amendments have been made in view of comments made in the Office Action that clearly distinguish the presently pending claims over the cited prior art. Hence, it is respectfully requested that the amendment be entered.

This amendment could not have been made earlier as the amendment further defines the claims over the prior art in accordance with the suggestion made in the Office Action, the suggestion first being made in the outstanding Office Action. Hence, since there remain no further issues to be resolved, it is respectfully requested that the present amendment be entered.

In conclusion, it is respectfully requested that the present amendment be entered in order to place the application in condition for allowance, which allowance is respectfully requested.

USSN: 10/049,354  
Attorney Docket No: 3120.00030

The Commissioner is authorized to charge any fee or credit any over-payment in connection with this communication to our Deposit Account No. 11-1449.

Respectfully submitted,

KOHN & ASSOCIATES, PLLC



Kenneth I. Kohn, Reg. No. 30,955  
30500 Northwestern Highway  
Suite 410  
Farmington Hills, MI 48334  
(248) 539-5050

Dated: December 26, 2003

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I hereby certify that this correspondence is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" addressed to Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on December 26, 2003.

  
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Connie Herty